

## RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte STEVEN B. SADINSKY

Appeal 2007-0522  
Application 10/723,817  
Technology Center 3700

MAILED

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U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Oral Hearing Held: March 6, 2007

Before ANITA GROSS, JENNIFER BAHR, and ANTON FETTING  
Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

THOMAS DALY, ESQUIRE  
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33 The above-entitled matter came to be heard on March 6, 2007,  
34 commencing at approximately 9:02 a.m., at the United States Patent and  
35 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Deborah  
36 J. Jackson, Notary Public.

1           USHER: Good morning. Calendar Number 1, Appeal Number 2007-  
2 0522, Mr. Daly.

3           MR. DALY: Good morning.

4           JUDGE GROSS: Good morning.

5           JUDGE BAHR: Good morning.

6           JUDGE FETTING: Good morning.

7           MR. DALY: Shall I just go right ahead?

8           JUDGE GROSS: As soon as you're ready; you have twenty minutes.

9           MR. DALY: Good morning, Judges. My name is Tom Daly, from  
10 Christie, Parker & Hale, appearing on behalf of the Appellant.

11           I have with me Steve Sadinsky. He is the inventor and also the  
12 president of the Assignee, Guardian Pool Fence Systems, Inc.

13           I also brought with me, and you will want to take a look at this, this  
14 (indicating) is an example of one of the embodiments of the invention.

15           It has the fence pole. There is an insert that goes inside the fence  
16 pole, and then this (indicating) is the pin that -- the claims talk about the pin  
17 that goes in the insert inside the fence pole.

18           There is also, along one side (indicating) a strip. There are screws  
19 that go through, and that's what would hold the mesh that would make up the  
20 fence to the pole.

21           The important issue in this case is the proper interpretation of adapted  
22 to.

1        Claim Eighteen talks about the pin being adapted to be inserted into a  
2        drilled socket in a pool deck.

3        The terminology, adapted to, just by common meaning, it means that  
4        it has to be made more fit, or designed to work for a particular purpose.

5        It is not just able to serve a purpose, but instead, something that's been  
6        particularly designed to serve a purpose, I think, in a way that will make it  
7        work for that purpose.

8        And in the context of this particular Application, where the  
9        specification talks about the need to provide a more stable, rigid structure at  
10       and near the gate -- which is found on page one, lines thirty-four through  
11       thirty-five of the Specification -- the fact that the pin is adapted to be  
12       inserted into a drilled socket in a pool deck is more than just a statement of  
13       intended use; it has a definite impact on the structure of the pin.

14       The pin has to be something that has been designed to fit into that  
15       socket in such a way that you can, in fact, create that stable, rigid structure at  
16       or near the gate.

17       The art that has been cited against Claim Eighteen, the Rasso Patent  
18       and the O'Fearna Patent, they disclose structures that I believe are not  
19       adapted for that purpose.

20       They are not adapted to be inserted into a drilled socket in a pool  
21       deck.

1        The Rasso Patent shows a sharp, widened, chisel-shaped tip on its  
2    fence post. That type of a tip, if it were put into a drilled socket, would not  
3    be as stable in that type of a socket.

4        Because of the widened tip, you would have to drill a much larger  
5    opening to try and fit that tip down into that opening, which would then  
6    allow the tip to wobble.

7        Not to mention the fact that if you have a sharp tip and you are trying  
8    to put it into a socket, you are going to run the risk of damaging the socket.  
9    You are going to have the sharp tip that is going to be hitting along the edges  
10   if you don't get it directly into the socket.

11        And the sharp tip is completely wasted. When you have a socket, you  
12   don't need a sharp tip.

13        The reason that Rasso has a sharp tip is because it's meant to be driven  
14   into the ground.

15        The other problem is that it has an irregular shape, so I suppose the  
16   argument could be made, turning it around, well, what if we made the socket  
17   adapted for this particular tip?

18        It's not exactly the way the claim is set up, but even if you did that,  
19   you would then have a socket that was oriented in a particular direction. It  
20   would not be something where you could put that tip into that socket in any  
21   direction.

22        You would have to put it in only one way.

1        That, actually, would be a real disaster with this fence, because what  
2        you have is, you have the mesh that's going to be attached to these fence  
3        poles. And so each pole is going to be connected to one another, and you  
4        are going to be putting them down into a socket.

5        If you had a situation where you had to orient those sockets in a  
6        particular direction, or you know, you would have to orient them, and you  
7        have to make sure that the fence had the tips each oriented in the same  
8        direction to be able to put it in, you know.

9        God forbid if you should happen to put the fences and the posts in in a  
10      slightly different order.

11       So the fact that that has an oriented -- would have an oriented -- would  
12      require an oriented socket, which would not be capable with a drill, in a  
13      drilled socket, would also cause a problem.

14       When you look at O'Fearna, that has a hollow tube. It looks like it's  
15      probably a PVC tube that's been cut at a very sharp angle to form a sharp tip  
16      at one side.

17       That, again, would not be a very stable structure inside a socket. The  
18      sharp tip, again, can cause damage to the socket, and it is completely wasted  
19      in the context of the socket.

20       Once again, if you were then to say, okay, well, let's adjust the socket  
21      to match the tip, again, you couldn't do it with drilling, because of this  
22      irregular shape. It's not regular with respect to a central longitudinal axis.

1        So you would then have to have a special socket that was oriented in a  
2    particular direction to hold this in a more stable way, which would then  
3    cause the same problem with trying to make sure that you had the poles all  
4    oriented in the right way with the particular socket, and you wouldn't have  
5    the advantage of having a nice, regular hole that you can drill the holes.

6        You can go ahead and put the pin in the socket and it wouldn't matter  
7    which particular direction the fence happened to be taking at that particular  
8    point.

9        JUDGE GROSS: Wouldn't the stability depend on how deep you  
10   made the holes? I mean, if you make the hole deep enough, the tip really  
11   doesn't matter.

12        MR. DALY: Well, that may be the case with O'Fearna, to some  
13   extent. The problem with Rasso is it's wider.

14        JUDGE GROSS: Right.

15        MR. DALY: With O'Fearna, I suppose you could make it deeper.  
16   That, to some extent, defeats the purpose, because you would then have to  
17   make your, you know, we are trying to minimize the amount of socket that  
18   we have to create.

19        But you still are going to have at the very bottom this tip part  
20   (indicating) that could, you know, break off or lead to some instability, in  
21   terms of how well it's seated in that socket, because it doesn't have a nice flat  
22   bottom to rest in the socket.

1        For those reasons, I don't think that Claim Eighteen is anticipated by  
2 either Rasso or O'Fearna. They just do not disclose anything that is adapted  
3 to be put into a socket.

4        They are intended for an entirely different purpose, to be driven into  
5 the ground. They, basically, are intended for a situation where you would be  
6 able to dispense with a socket altogether.

7        With respect to -- that also would apply to any of the claims  
8 depending on Claim Eighteen.

9        We then go and take a look at the rejections to Claims One through  
10 Seventeen, where the issue was a combination of one of Mr. Sadinsky's  
11 earlier Patents with O'Fearna.

12       I think the problem with that rejection is that there is no real  
13 motivation to combine those two references.

14       If you have the situation where you are putting a fence into sockets,  
15 but they are larger sockets in the prior art, and you wanted to then combine  
16 O'Fearna, which has these sharpened poles that are meant to be driven into  
17 the ground or into sand, why would you be combining those?

18       Well, the main motivation, I would think, to combine those, would be  
19 if you were going to take these sharpened poles or tips and put them onto the  
20 fence poles, and thereby dispense with the need for a socket.

21       That's the whole point of O'Fearna, you can drive it into the sand.

1        So if you were to combine these, the reason you would be doing it  
2    would be to basically get rid of the socket.

3        And if you did that, you basically would be trying to drive poles or  
4    these tips into an undrilled pool deck, which would be, to some extent, a  
5    complete disaster, trying to drive these things in.

6        You wouldn't be trying to do it to come up with a tip that was adapted  
7    to go into a socket, because the whole point of O'Fearna is that we don't need  
8    a socket; we can just take our sharp tip and put it into the sand.

9        So I don't think that anyone would be combining those two references  
10   to try and come up with something that had a narrower tip that was adapted  
11   to be put into a socket.

12       You would be doing it to try and get rid of the socket.

13       So you would also be, you know, any benefit you might gain from  
14   putting this sharpened tip of O'Fearna, I think would be lost by the problems  
15   you would have with the stability issues, the possible damage that you could  
16   cause to the socket, and of course, if you really went along with the idea that  
17   you were trying to drive it into the deck, that would, obviously, be a much  
18   more difficult method of installation than being able to take them and just  
19   stick them into pre-drilled sockets.

20       JUDGE GROSS: I have some questions.

21       MR. DALY: Okay.

1           JUDGE GROSS: In your specification you disclose that that  
2    structure, with the pin sticking out, there were no gate poles for a swimming  
3    pool.

4           You say that it wasn't previously used for a gate pole, but why does  
5    your disclosure of that structure not meet Claim Eighteen?

6           MR. DALY: Claim Eighteen specifies that it be a gate pole.

7           JUDGE GROSS: But what, in the preamble of gate pole, what  
8    structure is implied by that?

9           MR. DALY: Well --

10          JUDGE GROSS: Let me put it another way. Why should we give  
11    patentable weight to the word, gate, in the preamble?

12          MR. DALY: In a fence, there's a reason why they didn't put it into the  
13    gate poles, and that is basically that the gate is the part of a fence that is  
14    subject to the most use and stress from the people opening and closing the  
15    gate.

16          And that means that when you get to the gate, what they were doing in  
17    the prior art, was there were basically bolting the poles directly to the  
18    concrete, because they were very worried that they would not be sufficiently  
19    stable.

20          In some of the dependent claims, we point out that what my client has  
21    done is he has come up with a much better way of making sure that this pin  
22    will remain stable within the pole.

1        And that allowed him to use it for a gate pole, whereas it was not  
2 previously believed capable of -- this type of structure wasn't believed  
3 capable of withstanding the type of stress that the gate would undergo.

4        JUDGE GROSS: All right. That being said, for the remaining  
5 claims, the entire fence, including the gate pole, a similar question.

6        Why would those claims not have been obvious over the Sadinsky  
7 Patent in view of the prior art?

8        You say that the reason that it wasn't used for a gate pole was because  
9 of stability, but the Sadinsky Patent already has two poles on each side of the  
10 gate to increase that stability.

11       So why would it not have been obvious in view of your disclosed --  
12 your admitted prior art in the specification, to substitute that structure with  
13 pins for the poles in the Sadinsky Patent?

14       MR. DALY: The Sadinsky Patent increases the stability by putting  
15 pairs of poles which, I guess, kind of illustrates the degree of concern there  
16 was about stability at the gate point.

17       And going from that, to this type of a pin structure, would have been,  
18 essentially, viewed as a step backwards.

19       You know, going to a pair of poles to increase the stability and the  
20 strength, and then putting a pin on it, would basically, you know, you would  
21 have been saying, well, okay, now I'm going to have to be giving up some of  
22 that strength and stability that I've gained by putting a pair of poles.

1        And what no one realized is that the structure could be set up in such a  
2    way that you could actually have a very stable situation using this kind of a  
3    pin.

4        JUDGE GROSS: Is that everything?

5        MR. DALY: Those are the concerns.

6        JUDGE GROSS: Any questions?

7        JUDGE FETTING: No questions.

8        JUDGE BAHR: No questions.

9        MR. DALY: Thank you for your time.

10       JUDGE GROSS: If you could leave a card with our stenographer so  
11    she can get your name right.

12       MR. DALY: Sure.

13       (Whereupon, at approximately 9:21 o'clock a.m., the hearing in the  
14    above-entitled matter was concluded.